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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,248	08/24/2001	Dirk Kolowrot	H3381 PCT/US	7954

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EXAMINER
MUSSER, BARBARA J

ART UNIT	PAPER NUMBER
1733	16

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

MK-15

Advisory Action	Application No.	Applicant(s)	
	09/787,248	KOLOWROT ET AL.	
	Examiner	Art Unit	
	Barbara J. Musser	1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *see attachment*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *15-35*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

ATTACHMENT

Continuation of 2. NOTE: The oil having a viscosity of 20-300 mPas at 20C and the adhesive containing a mixture of poly-alpha-olefins would require further search and/or consideration.

Regarding applicant's argument that Iwami et al. is not available as art, in certain circumstances, references cited to show a universal fact need not be available as prior art before applicant's filing date. *In re Wilson, 311 F.2d 266, 135 USPQ 442 (CCPA 1962)*. Such facts include the characteristics and properties of a material. The reference is only being used to show a property of a material.

Regarding applicant's argument that Clearon P105 is a trademark and thus the composition can change, the two references were filed within 3 years of each other. It is unlikely the composition would change enough in that small length of time to make the softening temperature outside applicant's range, considering how large that range is. Applicant has failed to provide any evidence the trademark composition has changed. Absent evidence showing that when Suzuki et al. was filed, the softening temperature of Clearon P105 would have been outside applicant's range, Clearon P105 is assumed to have the softening temperature shown in Iwami et al.

Applicant argues that if softening temperature was important why wasn't the softening temperature of the APAO and hydrocarbon resin given. As a trademark name with a known softening temperature is given, the reference did implicitly disclose the hydrocarbon softening temperature. Regarding the lack of a softening temperature for the APAO, that the primary reference did not consider it important to list every property

of the APAO does not mean choosing a softening temperature in applicant's range would not have been obvious.

Regarding applicant's argument that the viscosity of Suzuki et al. would fall outside applicant's range since the viscosity is measured at 180C, not 150C, and that a decrease of 10 C doubles the viscosity, this is not a hard and fast rule, but rather a generalization. Many materials do not exhibit a doubling of viscosity with a ten degree drop in temperature. It is dependent on the specific composition. Additionally, using that rule, the adhesive of Suzuki et al. would still have a lower limit of 4000, which would overlap with that of applicant.

Regarding applicant's argument that the APAOs of Kehr et al. are highly viscous, they fall within applicant's range.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., adhesive being a storage, stable adhesive having superior initial adhesion for use with heat sensitive substrates) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kehr et al. discloses that the APAOs of the reference have better sprayability than other APAOs and the adhesive of Suzuki et al. is sprayable.(Col. 8, ll. 55)

Regarding applicant's argument that the plasticizer of Simmons is solid and would not be used as the plasticizer of Suzuki, examiner is not using the plasticizer of Simmons but rather the APAO.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Simmons et al. discloses the APAO has superior properties to those known previously.(Pg. 4, ll. 17-19)

Regarding applicant's argument that the adhesives of Lindquist et al. would not have been used in the manufacture of sanitary garments, such garments conventionally must be peelable from either the users garments or from around the user's body. Thus they require adhesives that are removable. Additionally, while the rejection mentioned the intended use, the claims do not recite it.

Regarding applicant's argument that the softening temperature of the APAO of Foster would not necessarily be between 90 and 125 C as the oil(liquid tackifier) has a low softening temperature and could affect the softening temperature of the adhesive, the reference does not require the oil to be present(Col. 2, ll. 37-38). Without an oil, the softening temperatures of APAO would need to be between 90 and 125 C for the combined adhesive to have a softening temperature between 90 and 125 C. Additionally, the APAO comprises the majority of the adhesive and thus its softening temperature would have a large effect on the softening temperature of the combined adhesive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (703)-305-1352. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Adrienne C. Johnstone

ADRIENNE C. JOHNSTONE
PRIMARY EXAMINER
GROUP ~~1300~~ Art Unit 1733

BJM
June 19, 2003